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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/800,641 | 03/07/2001 | Kent E. Seamons | GB920000044US3 | 3334 |

7590 12/13/2004

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EXAMINER

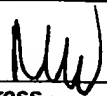
SHAH, ANKEETA

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|---|
| Office Action Summary | Application No. 09/800,641 | Applicant(s) SEAMONS ET AL. | |
| | Examiner Ankeeta Shah | Art Unit 3628 |  |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/19/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract is objected to since it refers to purported merits or speculative applications such as "The problem considered herein" and "subjects face the problem of determining".

Claim Objections

2. **Claim 7** is objected under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to

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cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A proper dependent claim shall not conceivably be infringed by anything, which would not also infringe the base claim. See MPEP §608.01(n), Section III. However the depending claim 7 recites, "A computer program product stored on a computer readable storage medium for, when run on a computer system, carrying out the method of claim 1." Applying the infringement test, what is needed to infringe claim 7 is, for example, a CD-ROM having computer executable code that if and when executed would cause a computer to do the steps recited in claim 1. However, such a CD-ROM would not infringe the method steps of claim 1 since the CD-ROM itself never performs any of the active steps recited in claim 1. In other words, mere possession of such a CD-ROM would infringe claim 7, but this is not enough to infringe claim 1. As a result, claim 7 is an improper dependent claim.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 - 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification. "Predetermined criteria" is not defined in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "Predetermined criteria" is indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1- 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandberg-Diment (US PAT 5,826,245).

Re claim 1, 7 and 8: Sandberg-Diment teaches a system and method comprising:

A automated trust negotiations between first and second parties connected over a network (see Fig 2), comprising the steps of: providing each party with a set of credentials, wherein a credential (i.e. customer name, portion of a credit card number,

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see column 2, lines 31-35 and column 3, lines 16-18) provides an authorization of a property of its respective party; classifying one or more credentials (classifying credentials is interpreted as customers name, address, tags and purchase order, see column 3 lines 17-20) in the set of credentials for said first party as sensitive (i.e. confidential, see column 1, lines 60-65), such that they can only be disclosed to another party subject to certain predetermined criteria (see column 1, lines 36-42); establishing negotiations over the network between said first and second parties in order to complete a desired transaction, wherein said transaction is only authorized to proceed if at least one of the parties receives certain predetermined credentials (i.e. a randomly generated tag, see column 1, lines 62-67) from the other party; and transmitting at least one of the one or more sensitive credentials from the first party to the second party as part of said negotiations (portions of a credit card number and/or a tag generated by a computer see column 2, lines 49-55), subject to the first party previously receiving from the second party one or more credentials that satisfy said certain predetermined criteria (i.e. sending the credit card information from the initiating party to the verifying party, see lines 40-48) ; wherein said first and second parties are a server (i.e. verifying party) and a client (i.e. initiating party) respectively, wherein said server is to perform the desired transaction in response to a request from the client (i.e. the initiating party, see column 1, lines 37-40); wherein the server specifies a set of credentials (i.e. the credit card number, see column 2, lines 32-33) that it must receive from a client in order to set up or perform the transaction (see column 2, lines 40-45); wherein both the client and the server have one or more credentials in their respective sets of credentials which are

classified as sensitive, such that they can only be disclosed to another party subject to certain predetermined criteria; wherein the negotiations over the network between the client and the server in order to complete a desired transaction include transmitting at least one of the one or more sensitive credentials from the client to the server as part of said negotiations subject to the client previously receiving from the server one or more credentials that satisfy said certain predetermined criteria for the client(see column 3, lines 8-22); wherein at least one party adopts an eager strategy, according to which all sensitive credentials are transmitted to the other party subject only to receipt of certain predetermined credentials from the other party(see column 2, lines 49-59), irrespective of whether or not transmission of such sensitive credentials is necessary in order to complete said transaction; and wherein at least one party adopts a parsimonious strategy, according to which only selected sensitive credentials are transmitted to the other party from the set of sensitive credentials that could be transmitted after receipt of certain predetermined credentials from the other party, said selection being performed on the basis of transmitting only those sensitive credentials that are specifically necessary in order to complete said transaction(see column 3, lines 43-54).

A Computer program would have been inherent to perform the method shown by Sandberg-Diment as stated supra.

Re Claim 2: The method, wherein said first and second parties are a client and a server respectively, wherein said server is to perform the desired transaction in response to a request from the client (see Fig 1 and 2).

Re Claim 3: The method, wherein in order to set up or perform the transaction, the client is required to supply at least one of the one or more sensitive credentials to the server(see column 1, lines 37-42).

Re Claim 4: The method , wherein said parsimonious strategy involves the exchange of credential requests to establish a point of confidence prior to transmission of credentials themselves(see column 2, lines 1-20).

Re Claim 5: The method, wherein at least one party initially adopts an eager strategy, according to which all sensitive credentials are transmitted to the other party subject only to receipt of certain predetermined credentials from the other party(see column 2, lines 1-3), irrespective of whether or not transmission of such sensitive credentials is necessary in order to complete said transaction, and then at a later stage of said negotiations subsequently adopts a parsimonious strategy, according to which only selected sensitive credentials(i.e. tag) are transmitted to the other party from the set of sensitive credentials that could be transmitted after receipt of certain predetermined credentials from the other party, said selection being performed on the basis of transmitting only those sensitive credentials that are specifically necessary in order to complete said transaction (see column 3, lines 10-15 and 23-27).

Re Claim 6: The method, wherein said server defines a service governing policy that specifies certain roles, such that said client can only set up or perform the transaction if it has sufficient credentials to allow it to assume one of said certain roles (i.e. the initiating party has to have a credit card number in order to perform the transaction, see column 1, lines 7-12).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (703) 305-0853. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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